

### R E M A R K S

Reconsideration of this application, as amended, is respectfully requested.

### THE CLAIMS

Claims 1-36 were rejected under 35 USC 112 as failing to comply with the enablement requirement. Specifically, the Examiner contends that the recitations of a "guide optical system" and "optical guiding means" in the claims are not supported by the disclosure in the specification.

It is respectfully submitted that the recitations of the guide optical system and optical guiding means were fully supported by the disclosure in the specification and drawings.

Nevertheless, in order to advance prosecution of the present application, claims 1, 12 and 23 have been amended to replace the terms "guide optical system" and "optical guiding means" with the more clearly supported term "an objective lens." In addition, claims 7, 18, 26, 30 and 31 have been amended to better accord with their respective amended parent claims.

It is respectfully submitted that the recitation of the objective lens, which is positioned between the active optical element (or pattern forming means) and the sample, in independent claims 1, 12 and 23 is clearly supported by the disclosure in the specification and drawings. For example, Fig. 1 shows an active

optical element 12, a sample 4, and an objective lens between the active optical element 12 and the sample 4 (see also the disclosure in the specification at, for example, page 8, lines 2-13, page 8, line 24 to page 9, line 1). Figs. 3 and 4 show an objective lens 6 between the sample 4 and the active optical element 12 (see also the disclosure in the specification at, for example, page 18, line 26 to page 19, line 5, and at, for example, page 20, line 26 to page 21, line 4). Fig. 5 shows the objective lens 3 between the sample 4 and an active optical element 25 (see also the disclosure in the specification at, for example, page 24, line 21 to page 25, line 12). And Figs. 6 and 7 show the objective lens 6 between the sample 4 and the active optical element 25 (see also the disclosure in the specification at, for example, page 31, lines 16-23, and at, for example, page 34, lines 1-10).

Clearly, therefore, no new matter has been added, and the claims are fully supported by the disclosure in the specification and drawings. Accordingly, it is respectfully requested that the amendments to the claims be approved and entered, and that the rejection under 35 USC 112 be withdrawn.

#### THE PRIOR ART REJECTION

Claims 1-5, 7, 10-16, 18 and 20-36 remain rejected under 35 USC 102 as being anticipated by USP 6,251,516 (previously

cited "Bonner et al"), and claims 6, 8, 9 17 and 19 remain rejected under 35 USC 103 as being obvious in view of the combination of Bonner et al and USP 5,756,586 (previously cited "Caprioli"). These rejections, however, are again respectfully traversed with respect to the claims as amended hereinabove.

Each of amended independent claims 1, 12 and 23 recites an active optical element on which a variable pattern is formed to correspond to a necessary area (claims 1 and 23) or pattern forming means for transmitting or reflecting the laser light selectively in accordance with a variable pattern which is set to correspond to a necessary area (claim 12), and an objective lens which is positioned between the active optical element or pattern forming means and the sample. According to the present invention as recited in independent claims 1, 12 and 23, laser light is irradiated through (transmitted through or reflected by) the active optical element or pattern forming means, and the laser light from the active optical element or pattern forming means is guided to the sample by the objective lens.

It is respectfully submitted that Bonner et al, whether taken singly or in combination with Caprioli, clearly fails to teach an active optical element/pattern forming means and an objective lens in the manner of the claimed present invention.

Indeed, the Examiner has not indicated what feature of Bonner et al she believes to correspond to the active optical element or pattern forming means of the present invention.

Since according to the claimed present invention the laser light travels to the sample via the active optical element (e.g., the laser light is transmitted or reflected by the active optical element or pattern forming means, through the variable pattern formed thereon), it would appear that the Examiner considers the transfer film 54 of Bonner et al to correspond to the active optical element or pattern forming means of the claimed present invention. It is respectfully pointed out, however, that Bonner et al discloses irradiating the transfer film 54 with laser light to cause the transfer film 54 to be selectively adhesive to the sample 50, so as to remove cells of interest 56 from the sample 50. Thus, in Bonner et al, it is critical that the transfer film 54 must be contacted to the sample 50 to obtain the cells of interest.

Accordingly, it is respectfully submitted that Bonner et al clearly does not disclose, teach or suggest that an objective lens is provided between the transfer film 54. In addition, it is respectfully submitted that the lens 60 and mirror 62 shown in Fig. 9 of Bonner et al are clearly not equivalent to the active optical element or pattern forming means of the claimed present invention, because no variable pattern is formed on either of

these elements. Still further, even if one of the lens 60 or mirror 62 of Bonner et al were considered to be an active optical element, no objective lens is provided between either of these elements of Bonner et al and the sample.

It is respectfully submitted, therefore, that Bonner et al clearly cannot logically be interpreted to disclose, teach or suggest an active optical element or pattern forming means and an objective lens in the manner recited in amended independent claims 1, 12 and 23.

Yet still further, it is once again respectfully submitted that Bonner et al also does not disclose, teach or suggest any of the structural features recited in dependent claims 2, 4, 5, 13, 15, 16, 24-26 and 34-36, for example, all of which were rejected as being anticipated by Bonner et al without any identification of disclosure in Bonner et al that might correspond to the subject matter of these claims.

Caprioli, moreover, has again merely been cited for the disclosure of a laser beam to release samples for analysis.

In view of the foregoing, it is respectfully submitted that the present invention as recited in each of amended independent claims 1, 12 and 23, as well as each of claims 2-11, 13-22 and 24-36 respectively depending therefrom, clearly patentably distinguishes over Bonner et al and Caprioli, taken singly or in combination, under 35 USC 102 as well as under 35 USC 103.

Entry of this Amendment, allowance of the claims and the passing of this application to issue are respectfully solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned for prompt action.

Respectfully submitted,

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